

07-01-04

Serial No. 09/815,628
Appeal Brief

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Attorney Docket No.: IDS-11605/14

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES**

Applicant: Frank Venegas, Jr.

Serial No.: 09/815,628

Examiner: Ryan M. Flandro

Filed: March 23, 2001

Group Art Unit: 3679

For: HAND RAIL SYSTEM

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest.

The real party in interest in this case is Frank Venegas, Jr., Applicant and Appellant.

II. Related Appeals and Interferences.

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims.

The application was filed with 24 claims. In an amendment filed November 6, 2002, new claim 25 was added. In a response filed to a Restriction Requirement (Paper No. 5), Appellant elected claims 5-21 for further prosecution. In an amendment filed November 6, 2002, Appellant canceled claims 1-3, 9-14 and 22-24, leaving claims 4-8, 15-21 and 25 pending in the

application. Claims 4, 16 and 18-21 have been withdrawn by the Examiner. Claims 5-8, 15, 17 and 25 are under appeal.

IV. Status of Amendments Filed Subsequent Final Rejection.

No after-final amendments have been filed.

V. Concise Summary of the Invention.

The present invention provides a knock-down hand rail assembly that is formed of both metal and plastic (specification, page 3, lines 9-10). The assembly can also readily be disassembled to form a different hand rail structure configuration or to add more rails to the structure (specification, page 3, lines 12-15). Further, the hand rail can be readily disassembled to change the plastic for the purpose of changing colors of the rail or adding/subtracting signage provided on the structure (specification, page 3, lines 15-17). The knock down hand rail assembly of the present invention includes at least two spaced apart vertical rails and at least two base supports for supporting the vertical rails in an upright position. Alternatively, the vertical rails may be supported by the ground using standard coring procedures (specification, page 3, line 19 – page 4, line 2). At least two spaced apart horizontal rails are provided and removably engaged with the vertical rails. These horizontal rails are preferably positioned above the base supports (specification, page 4, lines 2-4). Each vertical and horizontal rail is surrounded by removable and replaceable polymerized sheathing. The polymerized sheathing has an interior diameter equal to or greater than the outer diameter of each rail (specification, page 4, lines 4-6). Slip-on structural fittings are provided to removably engage the horizontal rails to the vertical rails (specification, page 4, lines 6-7). In other preferred embodiments, a plurality of vertical and horizontal rails surrounded by polymerized sheathing and engaged by slip-on structural fittings can be used (specification, page 4, lines 7-9). The vertical and horizontal posts or rails form a

perimeter frame and define a framed area (specification, page 4, lines 10-11). An infill panel is supported in the framed area. The infill panel may be a sheet of glass or polymer, steel mesh, or perforated steel (specification, page 4, lines 11-13). In some versions, slip-on structural fittings engage and removably interconnect the horizontal and vertical rails. Clips or brackets interconnect to the infill panel with the vertical and horizontal rails (specification, page 4, lines 13-15). In other embodiments, slip-in structural fittings are provided that have one end that engages the inner diameter of a horizontal or vertical rail, and another end that mounts to the side of another rail (specification, page 4, lines 15-17).

VI. Concise Statement of Issues Presented for Review.

1. Are claims 5, 6, 8, 17 and 25 unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,396,739 to Venegas (Venegas I), in view of U.S. Patent No. 5,364,077 to Venegas (Venegas II)?

2. Is claim 7 unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,396,739 to Venegas, in view of U.S. Patent No. 5,364,077 to Venegas, and further in view of U.S. Patent No. 5,474,279 to Parisien?

3. Are claims 15 and 17 unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,396,739 to Venegas in view of U.S. Patent No. 3,342,457 to Bobrowski?

VII. Grouping of Claims for Each Ground of Rejection Which Appellant Contends.

Appellant believes the following groups of claims represent patentably distinct subject matter requiring separate consideration on appeal:

Group I: Claims 5, 6, 8, 15, 17 and 25, wherein claims 5, 6, 8, 15 and 25 fall or stand with claim 17; and

Group II: Claim 7.

VIII. Argument.

**A. Group I – Claims 5, 6, 8, 15, 17 and 25, Wherein
Claims 5, 6, 8, 15 and 25 Fall or Stand with Claim 17.**

1. Claim 17 was rejected under 35 U.S.C. §103 over the combination of Venegas I and Venegas II. In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor chose to combine these particular things in this particular way. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

Venegas I discloses a guard rail assembly which is distinctly different from the hand rail assembly defined in claim 17. Venegas I discloses a guard rail assembly having a frame enclosed on three sides by a unitary metal tube formed with two intermediate 90 degree, radiused bends to form an inverted U-shaped structure. This U-shaped structure includes two parallel side legs 12 and 16 joined by a horizontal stanchion 22. This entire U-shaped section is covered by a polymer sheath. A second horizontal stanchion 26 extends between the vertical sections 12 and 16 midway along their lengths and joins them to form a generally quadrilateral frame.

Venegas I clearly lacks many of the features defined by claim 17. Claim 17 calls for "a pair of spaced apart vertical posts each having a lower end and an upper end . . .". The vertical stanchions 12 and 16 do not have well-defined upper ends. Second, claim 17 calls for

“replaceable polymerizing sheathing surrounding each of the posts . . .”. The Examiner argues that the drawing of the element 14 in Figure 3 suggests that it is replaceable. The Examiner is obviously referring to the circumferential gap in the element 14, necessary to clear U-shaped channel 32. However, a clear reading of the patent makes it clear that the sheath is not designed to be replaceable. As set forth in column 2, lines 33-36, “This tight fit of sheath 14 about the vertical stanchion 12 defers water from seeping between the stanchion 12 and the sheath 14, thereby preventing rusting of the stanchion 12.” No suggestion is made that the sheath may be removable. Clearly, the lower sections of the stanchion 14 and 16, below the horizontal stanchion 26 are fully surrounded by the polymerized material, making removal impossible.

Claim 17 continues “. . . an upper rail extending between the upper ends of the vertical posts . . .”. The upper rail does not extend between the upper ends of the vertical posts in Venegas I, but rather is formed integrally with the vertical posts joined by the radiused connecting sections at either end.

Claim 17 continues “. . . replaceable polymerized sheathing surrounding each of the rails . . .”. No suggestion is made in Venegas I that this sheathing is replaceable. The Examiner argues that it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the hand rail assembly of Venegas I to include releasable engagement between the rail and post members, for the purpose of facilitating removal and installation of said assembly at distinct locations as taught by Venegas II. This would require the formation of Venegas I as separate posts and rails, which would produce a mechanical structure quite different than that disclosed in Venegas I.

Venegas II discloses a hand rail assembly which differs radially from both Venegas I and from the present invention as defined in claim 17. The horizontal rails 46, 54 and 62 are formed

with apertures which receive the vertical posts 23 and their surrounding segmented sheath members. The rails do not extend between the vertical posts as defined in claim 17, but rather project well beyond the edges as illustrated in Figure 1. Accordingly, one of ordinary skill in the art would not recognize any teaching in either Venegas I or Venegas II which would suggest their combination to produce the structure defined by claim 17.

In connection with this rejection, the Examiner states that "... it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art." Citing *Nerwin v. Erlichman*, 168 USPQ 177, 179 (Bd. Pat. App. & Int. 1969). It is respectfully submitted that *Nerwin v. Erlichman* does not stand for the proposition cited by the Examiner. The case is a patent interference in which the issue involved whether the junior party could make the count of the interference. The pertinent portion at page 169 apparently is the quotation "The mere fact that a given structure is integral does not preclude its consisting of various elements." That is a totally different proposition than the one stated by the Examiner. It is respectfully submitted that constructing a formerly integral structure in various elements may or may not involve routine skill in the art depending upon the circumstances.

2. Claims 15 and 17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Venegas I in view of Bobrowski, U.S. 3,342,457. The Examiner concedes that Venegas I does not disclose that the rails are releasably engaged to the post. However, the Examiner does not consider the other claim limitations, noted above, which distinguish claim 17 and its dependent claim 15 from Venegas I. Again, Venegas I discloses an inverted U-shaped structure with radiused connections between the side posts and the rail, forming a handrail assembly, unlike the structure defined in claim 17. Vertical stanchion 12 is sheathed in a polymerized material 14. There is no suggestion in the specification of the patent that sheath 14

is removable as required by claim 17. On the contrary, because of the unitary nature of the vertical posts 12 and 16 and the upper horizontal rail 22, the sheath necessarily extends entirely around the tubing in the areas below the rail 26 and accordingly could not be removable.

Additionally, claim 17 speaks of the upper rail extending between the upper ends of the vertical posts. In *Venegas I* the upper rail is formed integrally with the posts and cannot be said to extend between the upper ends of the posts. Rather, the upper ends of the posts are replaced by the arcuately bent transition sections.

Claim 15 adds the limitation to claim 17 that the hand rail 17 further comprises structural fittings interconnecting the rails with the posts, at least one of the structural fittings comprising a slip-on fitting having an inner diameter greater than or equal to the outer diameter of the plastic sheathing in the posts or rails.”

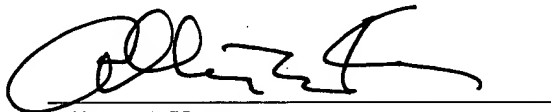
The Examiner recognizes that combining *Venegas I* and *Bobrowski* still lacks a disclosure that the inner diameter of the slip-on fittings is greater than or equal to the outer diameter of the plastic sheathings on the posts or rails. The Examiner finesses this absence with the statement that a change in the shape of the prior art device is a design consideration within the skill of the art, citing *In re Dailey*, 149 USPQ 47 (CCPA 1966). The Examiner’s abstract of the *Dailey* decision apparently derives from the Board’s statement that “Appellants presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surface in the collapsed container of Matzen” citing *Graham v. John Deere*, 383 US 1, 148 USPQ 459. To expand that statement to the generalization that a change in the shape of a prior art device is always a design consideration within the skill of the art is totally improper. The issue, as set forth in *Graham v. John Deere*, is

whether considering the disclosures of the cited references, it would have been obvious for one skilled in the art to arrive at a structure defined by the claims. There is no suggestion or teaching in Venegas I or Bobrowski which would lead to the structure defined in claim 17 or claim 15.

B. Group 2 – Claim 7.

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Venegas I and Venegas II, as applied to claim 5, further in view of Parisien, U.S. Patent No. 5,474,279. Claim 7 includes the limitation that the infill panel constitutes a mesh screen. The Examiner recognizes that neither Venegas I nor Venegas II disclose this but argues that Parisien teaches that mesh screens and solid infill panels are considered art recognized equivalents. The Examiner points to abstract lines 1-3 for this teaching, but there appears to be no specific disclosure in Parisien of an infill panel constituting a mesh screen. Certainly mesh fences are old in the art, but the cited art does not disclose or suggest their use for an infill panel in the claimed environment.

Respectfully submitted,



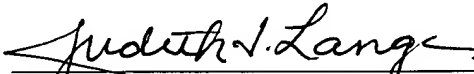
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Judith T. Lange

APPENDIX A

CLAIMS ON APPEAL

5. The hand rail assembly as defined in claim 17, wherein the infill panel has an area which substantially consumes the framed area; the panel being mounted in the framed area.
6. The hand rail assembly as defined in claim 5, further comprising one or more sections of U-channel affixed to each of the vertical posts and the rails for mounting the infill panel.
7. The hand rail assembly as defined in claim 5, wherein the infill panel is a mesh screen.
8. The hand rail assembly as defined in claim 5, wherein the infill panel is a solid panel.
15. The hand rail assembly according to claim 17, further comprising structural fittings interconnecting the rails with the posts, at least one of the structural fittings comprising a slip-on fitting having an inner diameter greater than or equal to the outer diameter of the plastic sheathing on the posts or rails.

17. A hand rail assembly with an infill panel, comprising:

a pair of spaced apart vertical posts each having a lower end and an upper end, the lower ends being configured to engage a support surface, each of the posts having a height and an outside diameter;

replaceable polymerized sheathing surrounding each of the posts, the sheathing having an inner diameter equal to or greater than the outside diameter of the posts, the sheathing extending substantially the entire height of the posts;

an upper rail extending between the upper ends of the vertical posts and releasably engaged to the upper ends of the vertical posts, the upper rail having a length and an outside diameter;

a lower rail extending between the vertical posts and positioned below the upper rail, the lower rail releasably engaged to the vertical posts and having a length and an outside diameter;

replaceable polymerized sheathing surrounding each of the rails, the sheathing having an inner diameter equal to or greater than the outside diameter of the rails, the sheathing extending substantially the entire length of the rails;

the vertical posts and the rails together defining a perimeter frame having a framed area defined therein, the framed area having a top edge defined by the upper rail, a lower edge defined by the lower rail, and sides defined by the vertical posts; and

an infill panel supported in the framed area.

25. The hand rail assembly according to claim 17, wherein each of said horizontal rails and said vertical posts comprise substantially straight members and said polymerized sheathing is substantially straight.